

REMARKS

The above referenced patent application has been reviewed in light of the Office Action, dated March 11, 2004, in which:

- claim 16 is objected to under 37 C.F.R. § 1.75;
- claims 11, 13-15, and 17-27 are rejected under 35 U.S.C. § 102(e) on Lotspiech *et al.* (hereinafter 'Lotspiech;' U.S. Patent No. 6,118,873);
- and claims 1-10, 12, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lotspiech in combination with Luther (U.S. Patent No. 5,533,127).

Reconsideration of the above referenced patent application in view of the foregoing amendments and the following remarks is respectfully requested.

A Petition for Extension of Time in order to extend the period for response 3 month(s), including the appropriate fee, is filed herewith.

Claims 1-27 are now pending the above referenced patent application. No claims have been cancelled, or added. Claims 1, 6, 11, 13, and 16 have been amended. Claim 13 has been amended to address a minor typographical error, and, therefore, the amendment does not result in prosecution history estoppel and does not alter the scope of the claims as originally intended. No new matter has been entered.

1. Request for Clarification

1.1. Status of Claims: 7 and 8

In the 35 U.S.C. § 103 summary section of the Office Action, the PTO has rejected claims 1-6, 9-10, 12, and 16. However, within the detailed section of the § 103 rejection, the PTO details a rejection of claims 7 & 8. Applicant assumes that these claims were inadvertently left out of the summary and are rejected by the PTO under the same grounds as claims 1-6, 9-10, 12 and 16. Applicant respectfully requests that the PTO clarify the rejection of these claims.

1.2. Status of Claim: 12

In the 35 U.S.C. § 102 summary section of the Office Action, the PTO has rejected claims 11-15, and 17-27. However, within the detailed section of the § 102 rejection, the PTO does not mention claim 12. In the 35 U.S.C. § 103 summary section of the Office Action, the PTO has rejected claims 1-6, 9-10, 12, and 16. Within the detailed § 103 rejection, the PTO details a rejection of claim 12. Applicant assumes that claim 12 was inadvertently added to the summary section of the § 102 rejection and is actually only rejected by the PTO under § 103. Applicant respectfully requests that the PTO clarify the rejection of this claim.

2. 37 C.F.R. § 1.75

2.1. Claim Duplication Objection: Claims 6 & 16

The PTO has objected to claim 16 under 37 C.F.R. § 1.75 as being a substantial duplicate of claim 6. This objection by the PTO of these claims is respectfully traversed.

M.P.E.P. § 706.03(k) sets forth the standard for a 37 C.F.R. § 1.75 objection:

706.03(k) Duplicate Claims

Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant's right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. **Indeed, a mere difference in scope between claims has been held to be enough.** (*emphasis added*)

Nevertheless, when two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other claim under 37 CFR 1.75 as being a substantial duplicate of the allowed claim.

Applicant begins with claim 6. Claim 6, as amended, recites:

- 1 6. (Currently Amended) The method of claim 1, wherein prior to performing arithmetic
2 operations on keys of at least two selected rows, the method further comprises:
3 dedicating the columns of the key matrix to a second classification.

Claim 16, as amended, recites:

- 1 16. (Currently Amended) The method of claim 11, wherein prior to performing arithmetic
2 operations on keys of at least two selected columns, the method further comprises:
3 dedicating the columns of the key matrix to a second classification.

Applicant notes that claim 16, as originally filed contained an inadvertent typographical error, and incorrectly depended upon independent claim 1. Applicant thanks the PTO for pointing out this error. Applicant has amended claim 16 to properly depend upon independent claim 11. No new matter is entered. The scope of the claim is not altered from its original intended scope, due to this amendment. Therefore no prosecution history estoppel should result.

Claims 6 & 16 now depend upon different independent claims, 1 & 11 respectively. Therefore, it is asserted that the two claims differ in scope and are no longer duplicates. It is, therefore, respectfully requested that the objection of these claim be withdrawn

3. 35 U.S.C. § 102(b)

3.1. *Lotspiech: Claims 11, 13-15, and 17-27*

The PTO has rejected claims 11, 13-15, and 17-27 under 35 U.S.C. § 102(b) as being anticipated by Lotspiech. This rejection by the PTO of these claims is respectfully traversed.

It is well-established that in order to establish a *prima facie* case of anticipation under § 102 of the patent statute, the PTO must provide a single prior art document that alone has every element and every limitation of the claim being rejected. Therefore, if even a single element or limitation is not met by the asserted document, then the PTO has not succeeded in establishing a *prima facie* case.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants begin with claim 11. Claim 11, as amended, recites:

1 (Currently Amended) 11. A method comprising:
 2 providing a key matrix having N rows and M columns of matrix keys, where
 3 $N \geq 2$ and $M \geq 2$;
 4 dedicating the rows of the key matrix to a first classification;
 5 for each row of the key matrix, performing arithmetic operations on matrix keys
 6 of at least two selected columns of the key matrix to produce a first set of secret device
 7 keys;
 8 producing a shared secret key based on arithmetic operations on selected secret
 9 device keys of the first set of secret device keys.

It is respectfully asserted that, as just one example of how the text cited by the PTO fails to meet the language of the rejected claims, Lotspiech does not show, teach, use, or describe dedicating the rows of the key matrix to a first classification. The PTO states that Lotspiech

shows this feature on Column 5, lines 30-40, but Applicant respectfully asserts that these lines merely explain what the variables N, S, and M mean, in plain English, to Lotspiech. Applicant fails to find where Lotspiech classify the devices in a manner similar to that seen in Applicant's specification. See page 8, lines 20-24.

Claims 13-15 and 17-27 either depend from claim 11, or include a substantially similar and patentably distinct limitation as claim 11. It is, therefore, respectfully requested that the rejection of these claims also be withdrawn.

4. 35 U.S.C. § 103(a)

4.1. *Lotspiech and Luther: Claims 1-10, 12, and 16*

The PTO has also rejected claims 1-10, 12, and 16 under 35 U.S.C. § 103(a) based upon Lotspiech in combination with Luther. The rejection of these claims is respectfully traversed.

M.P.E.P. § 706.02(j) sets forth the standard for a § 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (whitespace added).

Applicant begins with claim 1. Claim 1, as amended, recites:

1 (Currently Amended) 1. A method comprising:
 2 providing a key matrix having N rows and M columns of matrix keys, where $N \geq 2$ and
 3 $M \geq 2$;
 4 dedicating the rows of the key matrix to a first classification;
 5 for each column of the key matrix, performing arithmetic operations on matrix keys of at
 6 least two selected rows of the key matrix to produce a first set of secret device keys;
 7 producing a shared secret key based on arithmetic operations on selected secret device
 8 keys of the first set of secret device keys.

Applicant respectfully asserts that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for at least the following reasons.

It is respectfully asserted that neither Lotspiech nor Luther, either alone or in combination, suggests or describes dedicating the rows of the key matrix **to a first classification**.

See discussion above. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

Claims 2-10, 12, and 16 either depend from and include the limitations of claim 1, or include a substantially similar and patentably distinct limitation as claim 1. Therefore, these claims patentably distinguish from the cited patents on the same basis as claim 1. It is, therefore, respectfully requested that the PTO withdraw the rejections of these claims.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,



Justin B. Scout
Reg. No. 54,431

Dated:

Wed Sep. 8, 2004

c/o Blakely, Sokoloff, Taylor & Zafman, LLP
12400 Wilshire Blvd., Seventh Floor
Los Angeles, CA 90025-1026
(503) 264-0967

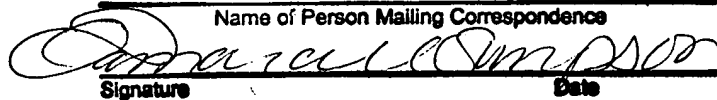
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on:

9/9/04

Date of Deposit

Tamara Simpson

Name of Person Mailing Correspondence



Signature

Date

9/9/04